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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,027	12/29/2000	Vinh Tran	06975-079001 / Network 03	6434
26171	7590	06/24/2005	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			PHAN, TAM T	
			ART UNIT	PAPER NUMBER
			2144	

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/750,027

Applicant(s)

TRAN ET AL.

Examiner

Tam (Jenny) Phan

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**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 06 June 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: NONE  
Claim(s) objected to: NONE  
Claim(s) rejected: 2-4, 6, 7, 11-13, 17-19, 21, 22, 24, 26-33, 35, 36, 38, 40-42, 53-57 and 61-99.  
Claim(s) withdrawn from consideration: NONE

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
Refer to the attached "Response to Arguments" document.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

MARC D. THOMPSON  
MARC THOMPSON  
PRIMARY EXAMINER

***Response to Arguments***

Applicants had presented numerous arguments against the previous final Office Action dated 03/04/2005. The Examiner has carefully considered these arguments and submitted that almost all of these arguments are related to the term non-electronic information and the applicants' interpretation of the term metadata. The previous Office Action interpreted non-electronic information as equivalent to metadata since according to Microsoft Computer Dictionary metadata is defined as "data about data. For example, the title, subject, and size of a file constitute metadata about the file..." Thus, one of ordinary skills in the art would disagree with applicants' definition of metadata as being "electronic data" (page 3 paragraph 4). Since metadata is data that describes the data content (i.e. title, subject, size, etc.), it is obviously the same as the non-electronic information that describes the electronic information.

In response to applicants' argument that the Office Action did not address the differences between claim 96 and claim 75 specifically the limitation "measuring an anticipated demand for the first electronic asset based on criteria that is collected before receiving requests for access to the first electronic asset and that is unrelated to past access requests, the criteria including non-electronic information", and requested a new Office Action that addresses the features of the pending claims, the Examiner respectfully submitted that, the Office Action has sufficiently cited the relevant passages to support the rejection of claim 96. For example, the previous Office Action cited from the Burns reference, "For each URL, the hit recorder 112 records hit information in a URL hit database 114. The hit information includes the date/time of the request, the

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subscriber who made the request, and other information. The hit recorder 112 also triggers a pattern recognizer 116 which draws on information in the URL hit database 114 to detect repetitive access behavior patterns based on subscriber requests. The pattern recognizer 116 performs statistical analyses using hit data from the URL hit database to determine usage patterns that help the local service provider be more responsive to the needs of its clientele. For instance, in the preferred implementation, the pattern recognizer 116 determines which URLs, and hence which Internet resources, are being requested most often and least often, and the time of day when the most requests are received. The pattern recognizer 116 is also responsive to operator input to allow adjustment or tuning by the operator for specialized analysis" (column 8 lines 43-59). This would suggest that the operator could configure the pattern recognizer to record an anticipated demand based on any information and parameters: whether it was the content of the electronic information, the non-electronic information related to the electronic information, past related request, or unrelated past request, etc. Thus, one of ordinary skills in the art would agree that Burns disclosed "measuring an anticipated demand for the first electronic asset based on criteria that is collected before receiving requests for access to the first electronic asset and that is unrelated to past access requests, the criteria including non-electronic information".

For clarification purposes, the Examiner would like to explain reasons for rejecting claims 96-99 using the same rational as claims 75-78. Refer to the claim listing, one of ordinary skills in the art would concur that the limitations in claims 96-99 and claims 75-78 are similar (although they are not the same). Thus, in the Office

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Action, claims 96-99 were rejected using the same rationale as claims 75-78, "same rationale" meant that the passages cited to reject claims 75-78 are applicable to reject claims 96-99.

The applicants had provided various arguments to illustrate that Burns, Pirolli, and Malkin only disclosed pre-fetched catching based on electronic information criteria, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Burns, Pirolli, and Malkin disclosed several embodiments and although, in one embodiment they did disclose pre-fetched catching based on electronic information criteria, they also disclosed in their other embodiments pre-fetched catching based on non-electronic information criteria, unrelated past request, etc.

MARC D. THOMPSON

MDT

PRIMARY EXAMINER